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STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.
1100 NEW YORK AVENUE, N.W.
WASHINGTON, DC 20005

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RECORD OF ORAL HEARING

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte CHARLES EDWARD ANDERSON, IV

Appeal 2010-001598
Application 10/080,671
Technology Center 2400

Oral Hearing Held: March 23, 2011

Before JOSEPH L. DIXON, LANCE L. BARRY, and CAROLYN D. THOMAS, *Administrative Patent Judges.*

APPEARANCES:

ON BEHALF OF THE APPELLANT:

ROBERT SOKOHL, ESQUIRE
Sterne, Kessler, Goldstein & Fox, PLLC
1100 New York Avenue, N.W.
Washington, D.C. 20005

The above-entitled matter came on for hearing on Wednesday, March 23, 2011, commencing at 1:51 p.m., at the U.S. Patent and Trademark Office, 600 Dulany Street, Alexandria, Virginia, before Victor Lindsay, a Notary Public.

PROCEEDINGS

THE USHER: Calendar Number 69, Appeal Number 2010-1598, Mr. Sokohl.

JUDGE DIXON: Good afternoon, counsel.

MR. SOKOHL: Good afternoon.

JUDGE DIXON: You have 20 minutes. You may begin when you're ready.

MR. SOKOHL: Great. Good afternoon. I represent the Appellant. There are two rejections we're going to be looking at today, a 102 and a 103. By way of example, though, I'd like to just provide a little background as to the invention. And for the record, I don't think I stated my name, but it's Robert Sokohl. May I approach? I have just two drawings that would make it easier.

JUDGE DIXON: Sure. These are in the record?

MR. SOKOHL: They are. They're part of the reference and the application. And I'd like to just turn to the second figure, which is titled Anderson Exemplary Gateway Operation, and this is one of the figures from the application.

Just real quickly, just to kind of get some context here, the invention has to do with resolving domain names. And what happens is that on the left-hand side, you'll see CPE or customer premise equipment. And the point is that the customer premise equipment wants to resolve a domain name which by doing so, they send it through the network to a domain name server, the point being to retrieve an IP address, and that IP address would be sent back to the CPE for then accessing a web page. Often times,

there's latency problems and sometimes a domain name server may not have the actual IP address and it may have to go to another domain name server or another request may have to be made. So the point of the invention was to place a cache in what's labeled the gateway, the Network Gateway 204 and to cache frequently used domain names so that you could then more easily access the IP addresses.

Now, just a little bit of context as well. In our patent application on page -- and this is not, this isn't the actual application as filed, not the published application. But on page 3 in paragraph 6, we define a network gateway and we say, quote, "As used herein, the term network gateway refers to any device that interfaces one or more CPE devices to a network, including but not limited to an IP network."

Now, just addressing the two rejections, I'll take them one at a time, the 102 first, *Himmel*. *Himmel* deals with Independent Claims 1, 22, and 39. Now, the claim, Claim 1 as an example, refers to providing the frequently accessed domain names to the communication network for transmission to the network gateway over a communication path. Now, the Examiner argues that the concept of a network gateway is not a limitation of this claim, that it is merely recited in the preamble and is in no way a limitation. And one of the problems with *Himmel* is that there is no network gateway that provides a cache for domain name system caching.

JUDGE DIXON: So are you arguing then that the claim, Independent Claim 1 expressly recites that -- and requires that a network gateway be present and that a cache be present as distinguished from your Claim 10 where the Examiner then addressed the claim differently under a different

statutory basis, but the Examiner's position seemed to be that you haven't expressly recited that the output actually makes it to a gateway and it's more of an intended use of it's going from the communication interface at Step B for transmission, but we're not transmitting it? It's only to the communication interface for transmission, you know, an extension of the intended use of the preamble to a network gateway, and the only place cache comes in is in the preamble for caching. We're not even expressly reciting that a cache is there, whereas as in Independent Claim 10 it expressly recites the gateway and the cache.

MR. SOKOHL: Okay, so I will try to address that question. So the answer is that the intent of Claims 1, 22, and 39 is to draft a claim from the side of the computer premises equipment, clearly, and the gateway is not a positively recited element and would not be required for infringement. What we tried to do here is -- the Federal Circuit has been clear on divided infringement and has stated a properly drafted claim could avoid divided infringement, and what we're trying to do here is capture an invention from the point of view of the CP and it is, in fact, different from the Claims of 10, I believe it's 10, 21, and 30, which do positively recite the network gateway, and we will deal with those in the 103, but that is a distinction, most certainly.

In regard to whether the preamble, though, is a limitation, I would argue it is and I would argue that in Claim 1 where -- first of all, where we recite that the network gateway is used for domain name system caching, that the method recited in Claim 1 must be configured to be used with such a gateway. So, for example -- and what do I mean by that? Well, first of all, I

do think that the recitation of the network gateway in Step B of Claim 1 could just as easily read, because the phrase -- meaning into his claim -- should read the network gateway for using domain name system cache. I think that that preamble of recitation should be brought right into the body of the claim. I think, because of the word the, it is there, but it is not positively recited. I also, however, believe that the -- if we look at, for instance, Claim -- Dependent Claim 7, I just want to give a little context there. Claim 7 talks about packetizing the frequently accessed domain names and providing the packetized information to the communication interface.

Now, let's talk about what *Himmel* is doing and what our invention is. *Himmel* is merely taking a bookmark and sending -- with a URL, sending a message to a server that's going to have that web page on it, okay? It is not intended in any way to send it to a network gateway for caching purposes. Now, what's the difference? Well, if we look at, for instance, Claim 7, where we're talking about packetizing the domain names, plural, that means putting it in -- putting this as part of the data of a message to the network gateway and -- for storage purposes, for storage purposes. And so you're packetizing plural names. Not a single bookmark, which is going to ultimately end up at a server, but you're packetizing plural names and sending it to a network gateway for caching purposes.

I believe as well that Claim B -- again, for this to be anticipated, the -- I believe, the invention of *Himmel* has to be intended to be used in the environment of a network gateway that has a cache that is configured for storing domain names, and without that recitation in the art, I believe it would not anticipate Claim 1. I also want to reference again, as I've

mentioned, Step B does include plural domain names. The reference does not teach providing plural bookmarks to the interface. The Examiner actually made an argument in regard to the preamble that so long as the structure of the art is capable of performing the intended use that it would anticipate. Well, I would disagree with that. Well, first of all, *Himmel* does -- is not capable of performing the intended use. *Himmel* does not teach a network gateway in any way that could be used for caching of domain names and there's just no recitation in *Himmel* that would allow that.

JUDGE DIXON: Where did you argue that point in your brief, about Claim 7 in your Brief or Reply Brief?

MR. SOKOHL: Claim 7? Sure.

JUDGE DIXON: Because in the Reply Brief, I notice that you -- I didn't recall seeing any arguments to Claim 7.

MR. SOKOHL: Correct.

JUDGE DIXON: You did have it in your brief, and then Examiner seemed to add additional -- an additional citation in his Answer, and then you didn't respond to that.

MR. SOKOHL: That is correct, we did not respond to it, but it is in the original --

JUDGE DIXON: So we take that as an admission then?

MR. SOKOHL: Absolutely not. I don't believe there's a requirement that you respond to every --

JUDGE DIXON: Okay.

MR. SOKOHL: No, it's not an admission, absolutely not. In fact, to the extent we didn't respond to something the Examiner made --

JUDGE DIXON: So if we find the Examiner's position relative to the his additional citation seems reasonable, then we have no comment, and so we can just accept it then, even though it's not an admission?

MR. SOKOHL: What the Examiner -- the Examiner merely argued that packetizing the frequently accessed domain names is inherent in any TCP/IP protocol. We don't disagree that sending packets over a TCP/IP protocol is new. What the argument is is that the art *Himmel* does not teach in any way packetizing domain names, plural domain names. It merely teaches using a URL to access a web page -- a server that has a web page. So we didn't see the -- we do not agree with the Examiner that his argument teaches packetizing plural domain names and sending them to a network gateway, but we do not disagree with the citation, you know, that he cites to deals with TCP/IP protocol.

JUDGE DIXON: But you just -- in your argument at page 19 of the brief, you basically just repeat the claim language and say the citation the Examiner has cited to does not teach, and then you repeat the claim language again. You never emphasize the aspect of the plural domain names. And then the Examiner further, goes further and gives another citation, and then you don't respond to it.

MR. SOKOHL: That is fair. That is fair, but it's certainly not an admission that we agree with the Examiner.

JUDGE DIXON: Okay.

MR. SOKOHL: Yeah, I would still argue that the Examiner is just merely saying that packets can be sent using TCP/IP and it doesn't mean that

domain names are sent as part of that TCP/IP packet. The art does not teach sending the domain names as part of a packet.

JUDGE BARRY: Your position would be it only sends one domain name at the most?

MR. SOKOHL: I would say that -- actually, my position would be it doesn't actually packetize the name. It sends a message to a web -- to a server to access a -- to confirm whether or not the URL has changed, or the -- or receiving --

JUDGE DIXON: But the TC IP [sic] protocol packetizes this -- the protocol that generally packetizes data, or it's -- for internet communication was what, I think, the Examiner's position was. It's, well, I've got packetizing because I've got TCP/IP, and that's your internet protocol, which is the most prevalent communication protocol, so the reference has packetizing something. And if we're packetizing something and I've got to send the -- one domain name out, I have to do at least one, so it's packetized. So he -- you know, it may not plural, and that could be disputed, but I've got packetized a domain name. It seems like that was the -- what the Examiner's position was --

MR. SOKOHL: And I think --

JUDGE DIXON: -- and nobody addressed the plural aspects, was my point, that I saw.

MR. SOKOHL: Yeah. I think that's -- the fact that there might be a packet, yes, I'm not going to dispute that. But I think that the argument was that domain names, plural -- it's in part of the clause -- is certainly not being packetized in *Himmel*.

JUDGE DIXON: Okay.

MR. SOKOHL: Okay. I'd like to move to the 103, which is *Himmel,* and hopefully I'll pronounce this correctly, *Schiuma*, in regard to Independent Claims 10, 21, and 30. Now, here, in 10, 21, and 30, we do explicitly recite a network gateway, and the point of these claims is that a domain name is sent to this network gateway, it resolves it, and then it caches the resolution, which is the corresponding IPI address, in the actual network gateway.

Now, *Himmel* does not teach caching a domain name in a network gateway. In fact, what the Examiner points to is two different pieces of *Himmel.* And if we turn to Figure 1, which I gave -- the first page I gave you, which is *Himmel* reference Figure 13, the Examiner actually refers in his Examiner's Answer to two different things, one thing in the 102 Rejection and another element in the 103. So we're a little confused as to exactly what he's arguing, but in both regards, it's different. In one regard, he points to the IO controller of *Himmel*, which is not actually shown in Figure 13, but is part of the CPE. The IO controller is clearly in the customer premises equipment. That cannot be a network gateway. He also points to the old server 503, which also is not the network gateway, but is actually a destination of the bookmark that we're sending the bookmarked URL. So neither is a network gateway. Neither is specifically designed to cache a domain name or the IPI address.

And in regard to *Schiuma*, he cites to paragraph 32 of *Schiuma*, which most clearly say that the browser which would be in the CPE would have caching capabilities for domain names, but, again, not a network gateway,

and I don't think any logical conclusion could lead to that what *Schiuma* teaches is a network gateway. So what we find here in regards to Claims 10, 21, and 30 is that there is a complete absence of a network gateway where you cache a domain name. And if there are no further questions on the 103 --

JUDGE BARRY: No.

JUDGE DIXON: Questions? Okay.

MR. SOKOHL: Well, thank you very much.

(Whereupon, the proceedings, at 2:08 p.m., were concluded.)